REMARKS

This Response is submitted in reply to the Office Action dated May 9, 2006. Claims 1, 4, 8, 13, 16, 25, 27, 30, 33, 42, 45, 49 and 52 have been amended. The specification has been amended. No new matter has been added.

A Petition for a Two Month Extension of Time to file this Response is submitted herewith. Please charge deposit account number 02-1818 for any fees which are due in connection with this Petition and this Response.

The Office Action rejected Claims 16 and 33 under 35 U.S.C. §112, second paragraph, for lacking a sufficient antecedent basis for the term "said predefined symbols." Accordingly, Applicants have amended Claims 16 and 33 to overcome these rejections.

The Office Action rejected Claims 1 to 52 under 35 U.S.C. §103(a) as being unpatentable over WO/98/35309 to Muir in view of U.S. Patent No. 6,824,465 to Luciano, Jr. ("Luciano").

Muir discloses a gaming system which includes a gaming server in communication with a plurality of game consoles. Predetermined outcomes are implemented using a smartcard as a secure storage and processing means with predetermines bets and outcomes stored as a list of values. In one implementation, the smartcard uses a random number seed (sent from the gaming server) to generate as many random numbers as required for the next game outcome. Muir also discloses a Keno game wherein the player first selects X unique numbers in the range 1 to Z which are sent as a message for the server to the smartcard. The game console then requests the smartcard to generate an array of Y unique numbers in the range 1 to Z and reads the generated numbers. The game console compares the X player selected numbers with the Y game console selected numbers and pays the player according to the number that match.

Luciano discloses an interactive keno game wherein the player is charged a predefined number of credits for each game selected symbol that is picked. In operation of the keno game, if there is a match between at least one game selected symbol and at least one player selected symbol, the game session is paused and a

prize may be awarded to the player. At this point, the player is provided an opportunity to terminate the game session (i.e., minimizing the player's losses) or wager additional credits for another game selected symbol to be picked.

The Office Action states that it would be obvious to one of ordinary skill in the art to modify Muir in view of Luciano to provide a keno game that changes or marks the player selected keno symbols and the game selected keno symbols. The Office Action states that this would allow the player to realize what symbols they selected and to see if the game selected symbols match theirs or not. Applicants respectfully disagree and submit that the gaming system of Luciano teaches away from employing predetermined game outcomes by enabling the player to stop the keno game prior to each game selected symbol being picked. That is, by enabling the player to stop the keno game prior to each game selected symbol being picked, the award or game outcome provided to the player is based on when the player decides to stop the keno game and is thus not predetermined. In other words, enabling the player to decide when to stop the keno game (and thus enabling the player to determine, at least in part, what award or outcome is provided) in Luciano teaches away from the predetermined game outcomes of Muir and thus such references are not combinable in the manner suggested by the Office Action.

Assuming, arguendo, that Muir and Luciano are properly combinable, for the reasons described below, the pending claims are still patentably distinguished over the combination of Muir and Luciano and in condition for allowance.

Claim 1 is directed to a gaming terminal including a primary wagering game operable upon a wager by a player, a plurality of player selectable symbols in the primary wagering game, a display device and a processor in communication with the display device. The processor is operable to enable the player to initiate a play of the primary wagering game and for the play of the primary wagering game to: enable the player to select one or more of the player selectable symbols, and associate at least one of the player selected symbols with one of a plurality of predefined symbols. For the play of the primary wagering game, the processor is also operable to associate at least one of the predefined symbols with a different one of the player selected symbols,

receive a game outcome seed from a central controller, determine a game outcome based on the received game outcome seed, and generate one or more game symbols based on the received game outcome seed. For each of the player selected symbols, the processor is operable to determine if the player selected symbol is associated with one of the predefined symbols, and if the player selected symbol is associated with one of the predefined symbols, present the predefined symbol to the player. For each of the predefined symbols, the processor is operable to determine if the predefined symbol is associated with one of the player selected symbols, and if the predefined symbol is associated with one of the player selected symbols, present the player selected symbol to the player. For the play of the primary wagering game the processor is also operable to present to the player at least one of the remaining generated symbols, and provide the player the determined game outcome in the primary wagering game.

The Office Action states that it would be obvious to one of ordinary skill to provide a keno game that displays to the user the symbols after being selected as modified, changed or marked in such a manner that the player is aware of the symbols previously selected, thus preventing the player from inadvertently selecting duplicate symbols, as well as to present to the player the game selected symbols in a modified or contrasting manner so the player can thus determine the randomly generated keno symbols. Applicants respectfully disagree and submit that modifying the generated game symbols in the gaming terminal of independent Claim 1 is patentably different than marking symbols to prevent duplicate selections of the symbols.

Nonetheless, to expedite prosecution of the present application, Applicants have amended independent Claim 1 to clarify that the gaming terminal associates at least one of the player selected symbols with one of a plurality of predefined symbols and associates at least one of the predefined symbols with a different one of the player selected symbols. Applicants have further amended independent Claim 1 to clarify that (1) for each of the player selected symbols, the gaming terminal determines if the player selected symbol is associated with one of the predefined symbols, and if the player selected symbol is associated with one of the predefined symbols, presents the predefined symbol to the player; and (2) for each of the predefined symbols, the gaming

terminal determines if the predefined symbol is associated with one of the player selected symbols, and if the predefined symbol is associated with one of the player selected symbols, presents the player selected symbol to the player.

As discussed during the telephone interview, neither Muir or Luciano individually, nor the gaming terminal resulting from the combination of Muir and Luciano teach, disclose or suggest associating at least one of the player selected symbols with one of a plurality of predefined symbols and associating at least one of the predefined symbols with a different one of the player selected symbols. Moreover, neither Muir or Luciano individually, nor the gaming terminal resulting from the combination of Muir and Luciano teach, disclose or suggest (1) for each of the player selected symbols, determining if the player selected symbol is associated with one of the predefined symbols, and if the player selected symbol is associated with one of the predefined symbols, presenting the predefined symbol to the player; and (2) for each of the predefined symbols, determining if the predefined symbol is associated with one of the player selected symbols, and if the predefined symbol is associated with one of the player selected symbols, presenting the player selected symbol to the player. That is, while the gaming terminal resulting from the combination of Muir and Luciano may utilize a smartcard to generate random numbers based on a received random number seed, the gaming terminal resulting from the combination of Muir and Luciano does not associate at least one of the player selected symbols with one of a plurality of predefined symbols and associate at least one of the predefined symbols with a different one of the player selected symbols. Moreover, the gaming terminal resulting from the combination of Muir and Luciano does not determine, for each of the player selected symbols, if the player selected symbol is associated with one of the predefined symbols, and if the player selected symbol is associated with one of the predefined symbols, present the predefined symbol to the player. Furthermore, the gaming terminal resulting from the combination of Muir and Luciano does not determine, for each of the predefined symbols, if the predefined symbol is associated with one of the player selected symbols, and if the predefined symbol is associated with one of the player selected symbols, present the player selected symbol to the player.

On the other hand, the gaming terminal of amended independent Claim 1 includes associating at least one of the player selected symbols with one of a plurality of predefined symbols and associating at least one of the predefined symbols with a different one of the player selected symbols. Moreover, the gaming terminal of amended independent Claim 1 includes (1) for each of the player selected symbols, determining if the player selected symbol is associated with one of the predefined symbols, and if the player selected symbol is associated with one of the predefined symbols, presenting the predefined symbol to the player; and (2) for each of the predefined symbols, determining if the predefined symbol is associated with one of the player selected symbols, and if the predefined symbol is associated with one of the player selected symbols, presenting the player selected symbol to the player. For these reasons, Applicants respectfully submit that amended independent Claim 1 is patentably distinguished over Muir and Luciano and in condition for allowance.

Claims 2 and 3 depend directly or indirectly from independent Claim 1 and are also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in these claims.

Similar to amended independent Claim 1, amended independent Claim 49 is generally directed to a method of operating a gaming terminal including, amongst other elements, associating at least one of the player selected symbols with one of a plurality of predefined symbols and associating at least one of the predefined symbols with a different one of the player selected symbols. As described above, neither Muir or Luciano individually, nor the method of operating a gaming terminal resulting from the combination of Muir and Luciano teach, disclose or suggest associating at least one of the player selected symbols with one of a plurality of predefined symbols and associating at least one of the predefined symbols with a different one of the player selected symbols. Accordingly, for this reason and the additional reasons described above with respect to amended independent Claim 1, Applicants respectfully submits that Claim 49 is patentably distinguished over Muir and Luciano and in condition for allowance.

Similar to amended independent Claim 1, amended independent Claims 4 and 8 are each generally directed to a central determination gaming system including, amongst other elements, at least one gaming terminal which includes a processor operable to associate at least one of the player selected symbols with one of a plurality of predefined symbols and associate at least one of the predefined symbols with a different one of the player selected symbols. As described above, neither Muir or Luciano individually, nor the central determination gaming system resulting from the combination of Muir and Luciano teach, disclose or suggest associating at least one of the player selected symbols with one of a plurality of predefined symbols and associating at least one of the predefined symbols with a different one of the player selected symbols. Accordingly, for this reason and the reasons given with respect to amended independent Claim 1, Applicants respectfully submits that Claims 4 and 8 are patentably distinguished over Muir and Luciano and in condition for allowance.

Claims 4 to 7 and 9 to 12 depend directly or indirectly from independent Claims 4 and 8 and are also allowable for the reasons given with respect to Claims 4 and 8, and because of the additional features recited in these claims.

Amended independent Claims 25, 42 and 52 are each generally directed to a gaming terminal/method of operating a gaming terminal including, amongst other elements, modifying the generated set of symbols by associating each one of the player selected symbols with a different one of the predefined symbols, associating each of the predefined symbols with a different one of the player selected symbols, and for each symbol in the set which is associated with another one of the symbols, replacing the symbol in the set with its respective associated symbol. As discussed during the telephone interview, neither Muir or Luciano individually, nor the gaming terminal resulting from the combination of Muir and Luciano teach, disclose or suggest modifying at least one of the generated game symbols by associating each one of the player selected symbols with a different one of the predefined symbols, associating each of the predefined symbols with a different one of the player selected symbols, and for each symbol in the set which is associated with another one of the symbols, replacing the symbol in the set with its respective associated symbol. That is, while the gaming

terminal resulting from the combination of Muir and Luciano may utilize a smartcard to generate random numbers based on a received random number seed, the gaming terminal resulting from the combination of Muir and Luciano does not modify the generated set of symbols by associating each one of the player selected symbols with a different one of the predefined symbols, associating each of the predefined symbols with a different one of the player selected symbols, and for each symbol in the set which is associated with another one of the symbols, replacing the symbol in the set with its respective associated symbol. On the other hand, the gaming terminal of amended independent Claims 25, 42 and 52 each include modifying the generated set of symbols by associating each one of the player selected symbols with a different one of the predefined symbols, associating each of the predefined symbols with a different one of the player selected symbols, and for each symbol in the set which is associated with another one of the symbols, replacing the symbol in the set with its respective associated symbol. For these reasons, Applicants respectfully submit that amended independent Claims 25, 42 and 52 are patentably distinguished over Muir and Luciano and in condition for allowance.

Claims 26, 43 and 44 depend directly or indirectly from independent Claims 25 and 42 and are also allowable for the reasons given with respect to Claims 25 and 42, and because of the additional features recited in these claims.

Similar to amended independent Claims 25, 42 and 52, amended independent Claims 27 and 45 are each generally directed to a central determination gaming system including, amongst other elements, at least one gaming terminal which includes a processor operable to modify the generated set of symbols by associating each one of the player selected symbols with a different one of the predefined symbols, associating each of the predefined symbols with a different one of the player selected symbols, and for each symbol in the set which is associated with another one of the symbols, replacing the symbol in the set with its respective associated symbol. As described above, neither Muir or Luciano individually, nor the central determination gaming system resulting from the combination of Muir and Luciano teach, disclose or suggest modifying the generated set of symbols by associating each one of the player selected symbols

with a different one of the predefined symbols, associating each of the predefined symbols with a different one of the player selected symbols, and for each symbol in the set which is associated with another one of the symbols, replacing the symbol in the set with its respective associated symbol. Accordingly, for this reason and the reasons given with respect to amended independent Claim 25, 42 and 52, Applicants respectfully submits that Claims 27 and 45 are patentably distinguished over Muir and Luciano and in condition for allowance.

Claims 28, 29, and 46 to 48 depend directly or indirectly from independent Claims 27 and 45 and are also allowable for the reasons given with respect to Claims, 27 and 45, and because of the additional features recited in these claims.

Amended independent Claim 13 is directed to a gaming terminal including, amongst other elements, a plurality of predefined symbols associated with a primary wagering game and a processor operable to bidirectionally map each player selected symbol with one of said predefined symbols. The processor is also operable to modify, based on said bidirectional map, each generated game symbol that is one of the player's selected symbols or one of the bidirectionally mapped predefined symbols.

The Office Action states the Muir anticipates the bi-directional mapping of player-selected symbols with the predefined symbols. The Office Action states that this is shown in the comparison and scoring of the keno game that determines if a player selected the correct numbers according to the game outcome. Applicants respectfully disagree. Applicants submit that the determination of if a player selected the correct numbers according to the game outcome in a keno game is patentably different than bi-directional mapping of player-selected symbols with the predefined symbols. As described on pages 30 to 31 of the specification, bidirectionally mapping includes mapping each one of the player's selected numbers onto a different one of the predefined numbers and reciprocally mapping the predefined number onto the player's selected number. As discussed during the telephone interview, Muir's disclosure of a smartcard generating random numbers based on a seed sent from a gaming server is patentably different than a gaming terminal bidirectionally mapping each player selected symbol with one of the predefined symbols and modifying, based on said bidirectional

map, each generated game symbol that is one of the player's selected symbols or one of the bidirectionally mapped predefined symbols. Applicants respectfully submit that neither Muir or Luciano individually, nor the gaming terminal resulting from the combination of Muir and Luciano teach, disclose or suggest bidirectionally mapping each player selected symbol with one of said predefined symbols. Applicants further submit that neither Muir or Luciano individually, nor the gaming terminal resulting from the combination of Muir and Luciano teach, disclose or suggest modifying, based on the bidirectional map, each generated game symbol that is one of the player's selected symbols or one of the bidirectionally mapped predefined symbols. On the other hand, the gaming terminal of amended independent Claim 13 includes a processor operable to bidirectionally map each player selected symbol with one of said predefined symbols and also operable to modify, based on said bidirectional map, each generated game symbol that is one of the player's selected symbols or one of the bidirectionally mapped predefined symbols. For these reasons, Applicants respectfully submit that amended independent Claim 13 is patentably distinguished over Muir and Luciano and in condition for allowance.

Claims 14 and 15 depend directly or indirectly from independent Claim 13 and are also allowable for the reasons given with respect to Claim 13, and because of the additional features recited in these claims.

Similar to amended independent Claim 13, independent Claims 30, 50 and 51 are each generally directed to a gaming terminal/method of operating a gaming terminal including, amongst other elements, bidirectionally mapping each player selected symbol with one of said predefined symbols and modifying, based on the bidirectional map, each generated game symbol that is one of the player's selected symbols or one of the bidirectionally mapped predefined symbols. As described above, neither Muir or Luciano individually, nor the gaming terminal resulting from the combination of Muir and Luciano teach, disclose or suggest bidirectionally mapping each player selected symbol with one of said predefined symbols. As further described above, neither Muir or Luciano individually, nor the gaming terminal resulting from the combination of Muir and Luciano teach, disclose or suggest modifying, based on the bidirectional map, each

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generated game symbol that is one of the player's selected symbols or one of the bidirectionally mapped predefined symbols. Accordingly, for this reason and the reasons given with respect to amended independent Claim 13, Applicants respectfully submits that Claims 30, 50 and 51 are patentably distinguished over Muir and Luciano and in condition for allowance.

Claims 31 and 32 depend directly or indirectly from independent Claim 30 and are also allowable for the reasons given with respect to Claim 30, and because of the additional features recited in these claims.

Similar to amended independent Claim 13, independent Claims 16, 20, 33 and 37 are each generally directed to a central determination gaming system including, amongst other elements, at least one gaming terminal which includes a processor operable to bidirectionally map each player selected symbol with one of said predefined symbols and modify, based on the bidirectional map, each generated game symbol that is one of the player's selected symbols or one of the bidirectionally mapped predefined symbols. As described above, neither Muir or Luciano individually, nor the central determination gaming system resulting from the combination of Muir and Luciano teach, disclose or suggest bidirectionally mapping each player selected symbol with one of said predefined symbols and modifying, based on the bidirectional map, each generated game symbol that is one of the player's selected symbols or one of the bidirectionally mapped predefined symbols. Accordingly, for this reason and the reasons given with respect to amended independent Claim 13, Applicants respectfully submits that Claims 16, 20, 33 and 37 are patentably distinguished over Muir and Luciano and in condition for allowance.

Claims 17 to 19, 21 to 24, 34 to 36 and 38 to 41 depend directly or indirectly from independent Claims 16, 20, 33 and 37 and are also allowable for the reasons given with respect to Claims 16, 20, 33 and 37, and because of the additional features recited in these claims.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited. If the Examiner has any questions related to this

Response, Applicants respectfully request that the Examiner contact the undersigned to discuss this Response.

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Respectfully submitted,

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Dated: <u>September 28, 2006</u>

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